

DISCUSSION OF THE AMENDMENT

Claims 1-20 are active in the present application. Claims 5, 6, and 10 are amended to correct typographical errors. Claims 17-20 are new claims. Support for the new claims is found throughout the specification, for example, in the paragraph bridging pages 2 and 3, page 10, lines 23-26, page 10, lines 28-31, and the examples on pages 11-12.

No new matter is added.

REMARKS

The amendment to the claims obviates the rejection under 35 U.S.C. § 112, second paragraph.

Applicants draw the Office's attention to new dependent Claims 17-20 which further define the claimed invention according to the descriptions for X, Y, the base and the metal compound.

The Office rejected the previously presented claims for lack of enablement under 35 U.S.C. § 112, first paragraph. The Office asserts that the specification: "[D]oes not reasonably provide enablement for compound of formula I wherein the X and Y are various groups with various substituents using any metal compound as embraced in Claim 1. The specification does not enable any person skilled in the art to which it pertains or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims." (See a paragraph bridging pages 2 and 3 of the October 23 Office Action). The Office provides a review of the *In re Wands* factors as a basis for asserting that the rejection is appropriate.

Applicants traverse the rejection. The Office's rejection of the claims boils down to nothing more than an objection to the breadth of the original claims and consists of nothing more than unsupported conclusory statements.

For example, the Office asserts that the specification is not adequately enabled for all of the organic radicals embraced by X and Y of Claim 1 and that, likewise, the specification is not adequately enabled for any metal compound (see page 3, *Wands* factor no. 1 of the Office Action). The Office refers to the predictability of the art in a fashion that shows that the Office has absolutely no idea whatsoever what is required to enable the processes encompassed by the claimed invention. The Office's statement with respect to predictability of the art is a nearly incomprehensible and empty conclusory statement:

Hence the process as applied to the above-mentioned compounds claimed by the Applicant is not an art-recognized process and hence there should be adequate enabling disclosure of the specification with working examples.

See *Wands* factor No. 2 on page 3 of the Office Action.

The Office's argument is wholly unsubstantiated and circular. In *Wands* factor no. 1, the Office argues that various features of the invention are not enabled by the specification. Then, in *Wands* factor no. 2, the Office concludes that because certain features are allegedly not adequately enabled, there is no adequate enablement in the specification. The Office's argument is completely unsupported with any reasoned technical argument or any evidence of record.

The Office's inability to articulate any reasonable technical basis for the rejection continues in its description of *Wands* factors nos. 3-7. The Office again does nothing more than conclude that the claims are not enabled without providing any comprehensible technical basis for reaching this conclusion.

Applicants, on the other hand, have provided real examples in the specification of the present specification to guide those of ordinary skill in the art on how to carry out the claimed invention. The examples show how the process is carried out for reactions using starting materials having particular X and Y substituents. Applicants submit that the examples of the specification demonstrate the invention; namely, that the claimed process functions appropriately when the halogen group is Cl or Br, contrary to what had conventionally been accepted.

To guide those of skill in the art, Applicants provided a general reaction equation on page 11 of the specification. Applicants submit that those of ordinary skill in the art can readily recognize that the aryl groups X and Y are exchangeable with other groups such that the reaction may occur.

Except for stating that only certain examples are described in the specification, the Office provides no basis for alleging that the specification is only enabled for reactions in which Y is a phenyl group and X is a phenyl group substituted with a -COOH group. In contrast to the Office's baseless assertions that the claimed invention lacks enablement, Applicants provided real examples in the specification of the present application to guide those of ordinary skill in the art.

In the Amendment filed in the present case on July 24, 2007 Applicants cited to the evidence of record that the rejection for lack of enablement is not supportable. The Wang publication shows that reactions between aryl halides and terminal alkynes are known to occur when the aryl species are substituted with a variety of alkyl groups or heteroatom-containing groups (see pages 8-9 of the July 24, 2007 Amendment). The Wang publication includes evidence supporting Applicants' arguments, i.e., that such reactions are enabled for a wide variety of organic substituents. The Office is obligated to consider this evidence but instead chooses to give it no patentable weight.

Patentability is determined based on a preponderance of evidence standard. The evidence in support of enablement (e.g., Wang) weighs in Applicants' favor. Applicants have provided evidence in support of patentability whereas the Office relies only on conclusory statements to support the rejection. Here, Applicants have provided more evidence in support of patentability than the Office has provided in contradiction thereof. Applicants' arguments should therefore prevail.

The rejection for lack of enablement should therefore be withdrawn and all now-pending claims allowed.

The Office further rejected the claims as anticipated by a publication to Erdelyi (*J. Org. Chem.*, 66 pp. 4165-4169 (2001)). The Office's inability to understand and examine the claims is reflected in its incorrect and baseless rejection. Applicants submit that Erdelyi does

not anticipate the presently claimed invention because Erdelyi reacts a silylacetylene compound with an aryl halide to obtain a silyl-substituted aryl acetylene. In contrast, the presently claimed invention reacts a organic radical-substituted acetylene with an organic halide to form an organic radical-substituted acetylene. The reactants and products of the presently claimed invention are different from the process described in Erdelyi.

Tellingly, after asserting that Erdelyi anticipates the presently claimed rejection, the Office rejected the claims as obvious over the combination of Erdelyi and Wang (J. Chem. Research, pp. 536-537 (2000)). The Office describes the disclosure of Erdelyi in a manner that directly contradicts the anticipation rejection:

Erdelyi et al., differs in not teaching use of alkyl carbonates and use of alkyl halides for the coupling process.

See page 7 of the October 24 Office Action.

More remarkably still, it appears that the Office completely ignored Applicants' arguments that it was conventionally known (i.e., as expressed in Kabalka) that chloro- and bromo-organics do not react well with terminal alkynes. Asserted above, Applicants provided real evidence in support of patentability of the claims. In contrast, the Office provided nothing but unsupported conclusory statements in support of the rejection.

Applicants submit that the presently claimed invention is not obvious over the combination of Erdelyi and Wang at least for the reason that prior to Applicants' invention it was conventional belief (as shown by Kabalka) that chloro- and bromo-organic radicals do not react with terminal alkynes in the way that iodo-organic radicals do.

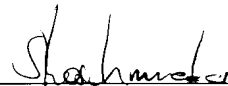
Applicants again draw the Office's attention to new dependent Claims 17-20 which require that the X and Y groups are, for example, aryl groups. Applicants submit that Erdelyi, and Wang nowhere disclose or suggest reactions such as those described in the

process of Claim 1 where X and Y are aryl groups. Thus, the new dependent claims are further patentable and not obvious over the prior art relied on by the Office.

For the reasons discussed above in detail, Applicants submit that all now-pending claims are in condition for allowance and the rejections should be withdrawn. Applicants request the mailing of a Notice of Allowance acknowledging the patentability of the presently claimed subject matter.

Respectfully submitted,

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